

DOCKET NO.: WSTE-0004
Application No.: 09/909,554
Office Action Dated: September 22, 2004

PATENT

REMARKS

In the first office action, the examiner requires restriction to one of the following inventions under 35 U.S.C. §121:

Group I: Claims 1-28, drawn to transportation facility access including authentication, classified in class 705, subclass 13.

Group II: Claims 29-81, drawn to conducting secure transactions including authentication, classified in class 705, subclass 67.

The examiner requires election of one group for prosecution on the merits, even if restriction is traversed, in accordance with 37 C.F.R. §1.143.

Election and Traversal

Applicant provisionally elects Group II (claims 29-81, drawn to conducting secure transactions including authentication, classified in class 705, subclass 67) for immediate prosecution, and respectfully traverses the restriction requirement, requesting reconsideration and withdrawal of same.

Applicant makes no representation by this election regarding the possible existence of multiple independent and/or distinct inventions among the claims of record. Pursuant to 37 C.F.R. § 1.143, the request for reconsideration is made to preserve applicant's right of petition should the examiner reassert restriction.

Examiner's requirement of demonstrating extra burden on the PTO has not been satisfied

Even if two or more claim groupings are independent or distinct as claimed, there must also be a serious burden on the examiner to require restriction. M.P.E.P. §803. If the search and examination of the entire application can be made without serious burden, the examiner must examine the application on its merits, in its entirety, even though the application includes claims to distinct and/or independent inventions. M.P.E.P. §803. The examiner has failed to show, in the present case, that examining both groups on the merits would present a serious burden.

In the office action, the examiner fails to show, or even mention, that a search and examination of the entire application would present a serious burden. The examiner, therefore, has not satisfied the criteria necessary for requiring restriction in this application.

Indeed, M.P.E.P. §803 requires, for proper restriction:

**CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

Since the examiner has failed, in the office action, to even address the second criteria (part B), the examiner has failed to satisfy his burden to show that restriction is proper.

Further, even if the examiner were to conclude that search and examination of the entire application would create a serious burden, which he has not, M.P.E.P. §803 further requires that the examiner provide reasons and/or examples to support the conclusions. In the present application, the examiner provides no reason or example to support his conclusion. The examiner does not claim that examination of either group requires search in a class or subclass having no art pertinent to the other group. Nor does the examiner indicate the purported different field of search. Even if the examiner indicated the different field of search, an explanation of how the different field of search was pertinent to the respective group, and only that group, is necessary.

Practical and equitable considerations mandate review of applicant's claims as a single application

A close examination of the practical and equitable considerations surrounding the present case compels withdrawal of the examiner's restriction requirement and requires inclusion of all the claims presented by applicant in a single patent application. The salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee. 35 U.S.C. §131.

The examiner's instructional guidelines for performing such a search for any application are set forth in the M.P.E.P. The guidelines compel the examiner to search in classes and subclasses in which independent and distinct inventions would be classified. For example, §904.01(c) recites:

"Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts regardless of where classified.

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. (emphasis added).

MPEP §904.01(d) recites:

A proper field of search includes the subclass in which the claimed subject matter of an application would be properly classified.

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, that may have material pertinent to the subject matter as claimed. Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant** to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

The examiner should plan a search that not only covers the claimed subject matter, but one that also covers the disclosed features that might reasonably be expected to be claimed.

MPEP §904.02 recites:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.

It thus results that the examiner finds references that, while not needed for treating the claims, would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his or her invention, and claimable with the subject matter being currently claimed, but shown to be old by these references.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) classes and subclasses in which the claimed subject matter is classified;
- (2) classes and subclasses that may have material pertinent to the claimed subject matter;
- (3) classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and
- (4) classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed.

Examination of Groups I and II will require overlapping searches

Only where inventions are independent and distinct and require non-overlapping searches, is restriction proper. Art relevant to the Group II claims will overlap considerably with the art relevant to the Group I claims. Indeed, Group II (class 705, subclass 67), which is directed to secure transactions, including intelligent tokens with authentication, is certainly applicable to, and/or could be incorporated into, an invention involving transportation facility access under class 705, subclass 13 (the Group I classification). Accordingly, the examiner will be required to search both subclasses when examining either of Group I or Group II.

Thus, the examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicant has

clearly manifested his intent to claim each novel and non-obvious aspect of the invention as evidenced by the claims in the application.

Examiner has further failed to show separate classification, for failure to show separate field of search

In concluding that restriction is proper, and therefore required, the examiner states in the office action: "because these inventions are distinct for the reasons given above [i.e., combination does not require particulars of subcombination, and the subcombination has utility by itself] and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper." The examiner has failed, however, to satisfy his burden of showing separate classification.

(Note: applicant assumes that the examiner, in the statement quoted above, relies on different classification, and not on separate status in the art, in concluding that restriction is proper, since separate status in the art, as referenced below in M.P.E.P. §808.02(B), requires that the groups be classified together, and requires that an explanation indicating a recognition of separate inventive effort by inventors be provided. In the present case, the examiner states that the groups are classified differently, and does not mention any explanation indicating recognition of separate inventive effort by inventors).

In requiring restriction, as articulated in the examiner's above-reference quotation, the examiner relies on M.P.E.P. §806.05(c), cited below:

I. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION

Restriction Proper

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct **and** restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search.

In accordance with M.P.E.P. §806.05(c), the examiner's requirement in satisfying separate classification is articulated in M.P.E.P. §808.02 *Related Invention*:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), **the examiner**, in order to establish reasons for insisting upon restriction, **must show** by appropriate explanation one of the following:

- (A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, *and* also a separate field of search. Patents need not be cited to show separate classification.
- (B) **A separate status in the art when they are classifiable together:** **Even though they are classified together:** each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.
- (C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

The examiner, in his above-quoted conclusion, has failed to show separate field of search, as required by M.P.E.P. §808.02(A). The examiner, in requiring restriction, has failed to even mention separate field of search. Accordingly, the examiner has again failed to satisfy his burden in requiring restriction in the present application, and has failed to satisfy his burden in showing that restriction, in the present case, is proper.

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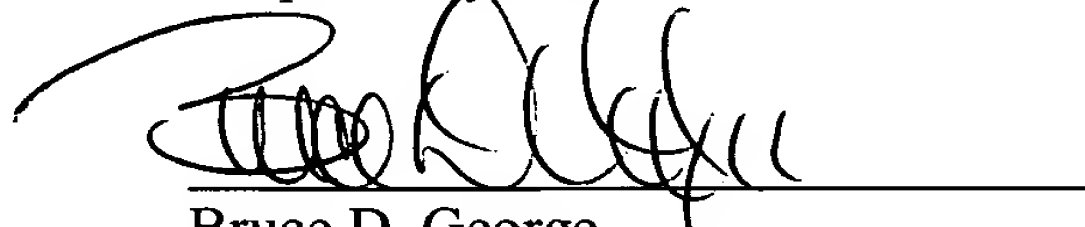
For the reasons presented by applicant in the previous section of this response, applicant submits that it would not be necessary, in the present application, for the examiner "to search for one of the distinct subjects in places where no pertinent art to the other subject exists." M.P.E.P. §808.02(C). Accordingly, Groups I and II of the present application do not require a separate field of search.

Conclusion

For the foregoing reasons, and particularly because the examiner has failed to satisfy his burden of showing: 1) extra burden on the PTO; and 2) separate classification thereof due to no separate field of search; applicant respectfully requests reconsideration and withdraw of the restriction requirement. Notification that the restriction requirement has been reconsidered and withdrawn is respectfully solicited.

Oct. 21, 2004

Respectfully submitted,



Bruce D. George
Registration No. 43,631

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439